In the

Supreme Court of the United States

OCTOBER TERM, 1976

No. 75-992

EDWARD E. IRONS,

Petitioner,

v.

COMMISSIONER OF PATENTS,

Respondent.

REPLY BRIEF IN SUPPORT OF PETITION

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No. 72-502

EDWARD S. IRONS,

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COMMISSIONER OF PATENTS,

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REPLY BRIEF IN SUPPORT OF PETITION

Respondent's brief has eloquently demonstrated that this case merits review in this Court for all of the reasons set forth in the petition. Thus,

1. Respondent has unconvincingly argued that "In actuality . . . the Court did not apply the equitable discretion doctrine" (R. Br. 5) even while acknowledging that the decision is based on a conclusion that the opinions and orders sought pursuant to the mandatory provisions of 5 U.S.C. 552(a)(2) are not "identifiable"—an exception to the statute's ambit created by the courts below in this case.[1] In short, the court below necessarily exer-

[1] 5 U.S.C. 552 expressly "does *not* authorize withholding of information or limit the availability of records to the public, except as specifically stated in this section". Lack of identifiability is *not* "specifically stated".

cised "discretion"—whether or not "equitably"—to decree that while a member of the public *may* be able to compel partial compliance with 5 U.S.C. 552(a)(2) he *cannot* obtain total compliance. *This* exception to the statute's ambit not being among the limited exemptions set forth in 5 U.S.C. 552(b) and hence in derogation of 5 U.S.C. 552(c), its adoption *sub silentio* overrules *Getman* v. *National Labor Relations Board*, 450 F.2d 670 (D.C. Cir. 1971), discussed at R. Br. 6, note 3, in direct conflict with *Wellford* v. *Hardin*, 444 F.2d 21 (4 Cir. 1971), quoted at Pet. 15-16.[2]

To put it shortly, respondent cannot, by any semantic ploy, including the advancement of fine-drawn distinctions between a request for "specific documents" (R. Br. 6, n. 3) . . . "specified information" (R. Br. 6, n. 5) and petitioner's request for all documents contemplated by 5 U.S.C. 552(a)(2) mask the fact that the decisions below fundamentally pose the transcendental problem of whether a duly enacted law of unquestioned constitutionality may be ignored or devitalized in the exercise

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[2] The contention that in *Wellford* "the Court of Appeals did not decide the issue" (R. Br. 6, n. 5) of whether equitable discretion may be invoked to vary or enlarge the exemptions set out in 5 U.S.C. 552(b) is in error. *Per contra*, relying on the language of 5 U.S.C. 552(c), the Fourth Circuit in *Wellford* held that "A broad construction of the exemptions would be contrary to the express language of the Act" (444 F. 2d at 25) and squarely affirmed the district court (315 F.Supp. 175) in *all* respects, including the latter's refusal to exempt records from production as *not* "identifiable"—an exemption *not* set out in the Act.

Note also that Congress has itself reaffirmed all of the legislative judgments underlying 5 U.S.C. 552 in Section 10 of P.L. 92-493, 92nd Cong., 2d Session, enacted October 6, 1972 wherein the limited exemptions to public availability of agency records expressed in 5 U.S.C. 552(b) are specifically incorporated by reference as the *sole* exceptions to public availability of the proceedings of governmental advisory committees. See in this regard particularly the discussion in Senate Report 92-1098, 92nd Cong., 2d Sess. at pp. 14-17.

of administration or judicial "discretion", "equitable" or otherwise. (Pet. 13-14).

2. Further emphasizing that the decisions below were in fact predicated upon an exercise of judicial discretion (whether or not "equitable") respondent argues that the number of decisions sought negates identifiability and hence excuses compliance with 5 U.S.C. 552(a)(2).[3]

Even the Court of Appeals was ultimately not fully satisfied with this "numbers game" approach. In its original decision it relied heavily (Pet. 4a) on Patent Office Solicitor Martin's controverted averments (par. 9) as to the *number* of decisions requested. After petitioner determined in a different case that paragraph 9 is false and so demonstrated on rehearing (Pet. 12, n. 13) the Court of Appeals retreated from its position that numbers alone compel an exercise of judicial discretion to excuse statutory noncompliance. To justify its continued holding of nonidentifiability, it was forced to find, *contrary to fact* on the face of 37 C.F.R. 1.14(b) and (d), that all unpublished manuscript decisions "are now public records" except for those contained in pending patent applications (Pet. 13) with the result that "the Patent Office was [not] required to reorganize" its alleged "mil-

[3] Obviously since the suppressed opinions cover the time span from 1853 to the present there *must* be "a very large number" (R. Br. 6 n. 4). Petitioner does *not* know, however, and has had no opportunity to find out just what the magnitude of the number is since the means for ascertaining that number is exclusively within the control of the Patent Office and petitioner was foreclosed below from discovery to ascertain the true facts in this regard.

The argument that the Martin affidavit "was not contradicted insofar as it stated that manuscript decisions exist in millions of files" (R. Br. 6, n. 4) is a play on words. As is demonstrated *inter alia* at Pet. 12, n. 13, petitioner *did* controvert consistently the inference that "millions of files" would have to be searched in order to find the requested decisions and repeatedly sought the opportunity to so prove in order to place respondent's "burden" argument in true perspective. See also Pet. 16, n. 17 which demonstrates that burden is irrelevant under the Act in any event.

lions of files" (Pet. 13(a)) for the convenience of the public including petitioner.

The whole saga of the "numbers game" approach in the court of appeals vividly demonstrates the need for review by this Court of the procedures invoked below including the district court's summary denial of discovery to petitioner and the appellate court's arbitrary acceptance of the *ex parte* sworn opinions and speculations of Patent Office Solicitor Martin as "evidence" notwithstanding petitioner's timely challenge under Rules 56(e) and (f).[4]

3. The irreconcilability of the decisions below with the agency burden under 5 U.S.C. 552(a)(3) and (c) to justify withholding of information is tacitly confessed by the advancement (R. Br. 7-8) of a *de novo* argument addressed to *this* Court's equitable discretion.

This new argument is to the general effect that the decisions, if produced, would be useless without an index and hence, there should be no public availability under 5 U.S.C. 552(a)(2) of decisions rendered prior to the July 4, 1967 effective date of the mandatory indexing requirement. This argument depends for viability on the

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[4] Had petitioner been permitted discovery in this case the falsity of Martin's paragraph 9 (Pet. 12, n. 13) could have been properly demonstrated on this record prior to appeal.

Moreover, as petitioner's Rule 56(e) and (f) showing demonstrates (A 41-56), timely challenge was consistently made to the other Martin averments. Petitioner *should* have been afforded an opportunity to demonstrate through discovery of facts under the control of respondent that the Martin affidavit contains many inaccuracies. In foreclosing such demonstration the court of appeals *sub silentio* overruled *Wellford* v. *Hardin*, 315 F. Supp. 768 (D.D.C. 1970) as the petition (p. 18-19) notes. Thus, contrary to R. Br. 6 n. 5, this latter *Wellford* case was not advanced to demonstrate a conflict in the circuits but, rather, to demonstrate the abject error into which the District of Columbia circuit has newly fallen *in this case*, in direct conflict with decisions of the courts of other circuits, *inter alia*, in cases cited at Pet. 18-19.

false representation that "Petitioner contends . . . that since the Patent Office does not have an index of unpublished decisions he could not identify the documents more specifically." (R. Br. 7) *But* petitioner has *always insisted* that the Patent Office *does* have at least one—and probably several—still suppressed indices to its unpublished decisions.[5]

Respondent further suggests the availability of the pre-July 4, 1967 decisions could only be of interest to "a litigant before the Patent Office" (R. Br. 8) and irrelevantly questions "what use petitioner would make of hundreds of thousands of manuscript opinions if . . . made available . . . without an index" (R. Br. 8, n. 6). Respondent's true objective in this case—to preserve inviolate from public scrutiny more than a century of secret Patent Office law and *not* to avoid "burden"—thus stands confessed. This purpose is hardly laudatory on the part of *any* Federal agency, much less one which exists, as the Patent Office does, for a *primary public* purpose.[6]

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[5] Respondent has admitted that there exists an index of 1853-1954 decisions in the front of each of the 174 chronological volumes in which those decisions are bound. (Pet. 9a). In addition petitioner believes and has repeatedly sought opportunity to prove below, that an "index" in the form of docket cards for each patent application, interference and appeal, exists internally in the Patent Office and that resort to *this* index would enable easy location by respondent of all material sought without any need to search "millions" of files. See petitioner's Rule 56(e) averments, paragraph 13(d) (A 53-4). Access to the former index has so far been denied below while facts concerning the existence of the latter which are solely within respondent's control remain suppressed with the concurrence of both courts below.

[6] Both Senate Report No. 813, 89th Congress, 1st Session and House Report No. 1497, 89th Congress, 2d Session, particularly recognize that it is a major objective of the Freedom of Information Act to make publicly available the secret law "embodied in thousands of orders, opinions, statements and instructions issued by hundreds of agencies". (House Report, p. 7). The Senate Report particularly

That the public, including petitioner, *is* prejudiced by the continuing secrecy of Patent Office precedent is apparent, *inter alia*, from Doerfer, "The Limits on Trade Secret Law Imposed by Federal Patent and Antitrust Supremacy" 80 *Harvard L. Rev.* 1432, 1444 (1967), as follows:

> ". . . when an examiner's action rejecting an application [for patent] is appealed, only reversals by the Board are available for future citation; rejected applications are kept secret. Since only rejections are appealed the only 'case law' which has developed in the Patent Office is composed of cases in which an examiner has been told that he should have allowed rather than rejected an application. In a future case the examiner cannot cite to the applicant cases in which he has been upheld in rejecting an application. The basic effects are two-fold: not only is the rational growth of a body of law stunted, but all the pressures of cited authority are against rejection and in favor of allowance."

Today the courts are deluged with suits on patents of increasingly tenuous validity and there is a "notorious

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notes that *all* of the material contemplated by the present 5 U.S.C. 552(a)(2) is to be made publicly available, albeit "considerations of time and expense cause . . . [the] indexing requirement to be made prospective in application only." (Senate Report, p. 7). The Senate Report also emphasizes that it is the specific purpose of 5 U.S.C. 552(c) to "make clear beyond doubt that all materials of the government are to be made available to the public by publication or otherwise unless explicitly allowed to be kept secret by one of the exemptions" in 5 U.S.C. 552(b).

As Professor Kenneth Culp Davis has observed "the governing principle [of 5 U.S.C. 552(a)(2)], which I think is without exception, is that secret law is forbidden". *Treatise on Administrative Law*, 1970 Supplement, p. 159. As he noted at the time the Act was passed "its accomplishments in opening up secret law are impressive. The most significant gains from the entire Act are those growing out of the requirement [in 5 U.S.C. 552(a)(2)] of disclosure of six items—orders, opinions, statements of policy, interpretations, staff manuals and instructions". "The Information Act: A Preliminary Analysis, 34 U. of Chicago L. Rev. 761, 804 (1967).

difference" in patentability standards between the Patent Office and the courts as noted in *Graham* v. *John Deere Co.*, 383 U.S. 1, 18 (1966). The question of whether the Patent Office can, on any pretext, continue to suppress its secret law in the teeth of 5 U.S.C. 552(a)(2), obviously merits this Court's attention.

4. *As to Rule 54(c) (Question 7).* There is, of course, no merit to respondent's argument that Rule 54(c) is indirectly satisfied and the conflict with other circuits obviated by "the fact that the court of appeals remanded so that the district court could further consider" the possibility of petitioner's entitlement to at least partial relief. It is futile to suppose that the district court, having already refused the petitioner's request and having been "affirmed" in this denial of relief will now take a different view in face of respondent's continued opposition. Nor, to the extent that the court of appeals may have authorized the district court in the exercise of its own discretion to depart from certain aspects of its prior ruling is there any real compliance with Rule 54(c) which requires that "*every* final judgment *shall* grant the relief to which the party *in whose favor it is rendered is entitled* even if the party has not demanded such relief in his pleadings". The form of "remand" below renders no judgment in favor of petitioner. It contemplates *only* a consideration by the district court of petitioner's request for certain indices plus the "possibility of such *amendment to the complaint* as the district court *may permit in the exercise of a sound discretion* should motion to that effect be made". (Pet. 10a) It thus fails to *guarantee* petitioner relief of any nature. It conditions the relief to which petitioner is tacitly acknowledged to be entitled in this case as it now stands, on the grant of a motion to amend the complaint in contravention of Rule 54(c) and thereby flatly conflicts with the cases cited at Pet. 20.

CONCLUSION

The petition for writ of certiorari should be granted.

Respectfully submitted,

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